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PATENT

Docket No. 56077US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#20
7/29/5/03

1 of 3

Applicant(s): C.V. ANDERSON et al.

Group Art Unit: 1734

Serial No.: 09/759,993

Examiner: Mark A. Osele

Confirmation No.: 1053

Filed: 12 January 2001

For: ADHESIVE FILM REMOVAL METHOD AND APPARATUS

RECEIVED
SEP 04 2003
TC 1700**APPELLANTS' BRIEF ON APPEAL**

Assistant Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is presented in support of the Appeal filed April 29, 2003 from the final rejection of claims 1, 4, 5, 8-13, 17, 18, and 21-25 in the above-identified application under 35 U.S.C. §§ 102 & 103 as set forth in the Final Office Action dated January 2, 2003.

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). Applicants hereby authorize a charge to Deposit Account No. 13-4895 in an amount sufficient to cover the fee for filing this Brief under 37 C.F.R. § 1.17(f).

I. REAL PARTY IN INTEREST

The real party in interest of the above-identified patent application is the assignee, 3M Innovative Properties Company.

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants' Representatives which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 4, 5, 8-13, 17, 18, and 21-25 are rejected and are the subject of this Appeal (see Appendix A).

Claims 6, 7, 19, and 20 are objected to as being dependent on a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims are not the subject of this appeal.

Claims 2, 3, and 14-16 were canceled during prosecution.

IV. STATUS OF AMENDMENTS

The present application was filed on January 12, 2001 with claims 1-25.

A first Office Action was issued on July 8, 2002 indicating that claims 6, 7, 19, and 20 were objected to but allowable if rewritten to include the limitations of their base and any intervening claims. Claims 1-5, 8-18, and 21-25 were rejected.

Applicants responded on October 8, 2002, canceling claims 2, 3, and 14-16 and amending claims 1, 4-6, 12, 17-19, and 22. As a result, claims 1, 4-13, and 17-25 remained pending after entry of the response.

A Final Office Action was issued on January 2, 2003, finally rejecting claims 1, 4, 5, 8-13, 17, 18, and 21-25 and reiterating the objected to but allowable status of claims 6, 7, 19, and 20.

Applicants responded on March 27, 2003 with proposed amendments that included canceling claims 6, 7, 19, and 20 (previously indicated as allowable) and presenting new claims 26-43 (providing the canceled claims in independent form with corresponding sets of dependent claims). Applicants also addressed the rejections of claims 1, 4, 5, 8-13, 17, 18, and 21-25.

An Advisory Action issued on April 2, 2003, indicating that the proposed amendments would not be entered. The Advisory Action also confirmed the objected to but allowable status of claims 6, 7, 19, and 20, as well as the rejected status of claims 1, 4, 5, 8-13, 17, 18, and 21-25.

As indicated above, Applicants filed a Notice of Appeal on April 29, 2003.

V. SUMMARY OF THE INVENTION

The present invention is directed to methods and apparatus for removing adhesive films from substrates. All of pending claims 1, 4-13, and 17-25 are found in Appendix A (attached).

Applicants submit that the pending claims are supported by the application as filed. To assist the Board in understanding the invention, however, Applicants provide the following analyses of the claims with respect to some of the illustrative embodiments of the invention described in the application as filed. It should be understood that Applicants reserve the right to show where the claims are additionally supported in the application as filed.

Independent claim 1 recites a method of removing adhesive film (112) from a substrate (114) as depicted in, e.g., Figure 4. The method involves applying tension over the width of the film (p. 4, lines 18-24). The method also includes transferring the tension applied to remove the film (112) back to the substrate (114) from which the film is being removed (p. 7, lines 13-19). The compressive force is applied to the substrate (114) at a distance from the release line (116), i.e., the line along which the adhesive film (112) parts from the substrate (114) (p. 7, lines 20-26). In the embodiment illustrated in Figure 4, the compressive force is applied by support roll (140) (p. 7, lines 13-15). The method further includes advancing the release line (116) towards the second end of the adhesive film (112) (p. 2, lines 11-12 & p. 8, lines 3-11).

Claim 4 depends from claim 1 and recites that the compressive force is applied to the substrate (114) behind the release line (116) as the release line advances toward the second end of the adhesive film (112) (p. 7, lines 20-25).

Claim 5 depends from claim 1 and recites that the compressive force is applied to the substrate (114) ahead of the release line (116) as the release line advances toward the second end of the adhesive film (112) (p. 9, lines 22-26 and Figure 7).

Claim 8 depends from claim 1 and recites that the compressive force is applied to the substrate by a roll (140) (p. 7, lines 13-15).

Claim 9 depends from claim 1 and recites that applying tension over the width of the adhesive film (112) comprises attaching the first end of the adhesive film to a winding roll (120) and winding the adhesive film thereon (p. 7, lines 8-15).

Claim 10 depends from claim 9 and recites that the compressive force is applied to the substrate (114) by a support roll (140), and further that the winding roll (120) and the support roll are located a fixed distance apart (p. 6, line 28 to p. 7, line 7).

Claim 11 depends from claim 1 and recites heating the adhesive film (112) before removing the adhesive film from the substrate (114) along the release line (116) (p. 9, lines 3-13).

Independent claim 12 recites a method of removing adhesive film (112) from a substrate (114) as depicted in, e.g., Figure 4. The method involves attaching the first end of the adhesive film (112) to a winding device (120) and rotating the winding device to apply tension over the width of the film (p. 4, lines 18-24). The method also includes transferring the tension applied to remove the film (112) back to the substrate (114) from which the film is being removed (p. 7, lines 13-19). The compressive force is applied to the substrate (114) at a distance from the release line (116), i.e., the line along which the adhesive film (112) parts from the substrate (114) (p. 7, lines 20-26). In the embodiment illustrated in Figure 4, the compressive force is applied by support roll (140) (p. 7, lines 13-15). The method further includes advancing the release line (116) towards the second end of the adhesive film (112) (p. 2, lines 11-12 & p. 8, lines 3-11).

Claim 13 depends from claim 12 and recites that the adhesive film (112) comprises a large-scale adhesive film (p. 4, lines 25-29).

Claim 17 depends from claim 12 and recites that the compressive force is applied to the substrate (114) behind the release line (116) as the release line advances toward the second end of the adhesive film (p. 7, lines 20-25).

Claim 18 depends from claim 12 and recites that the compressive force is applied to the substrate (114') ahead of the release line (116') as the release line advances toward the second end of the adhesive film (112') (p. 9, lines 22-26 and Figure 7).

Claim 21 depends from claim 12 and recites heating the adhesive film (112) before removing the adhesive film from the substrate (114) along the release line (116) (p. 9, lines 3-13).

Independent claim 22 recites an apparatus for removing adhesive film (112) from a substrate (114). The apparatus includes a winding roll (120) attached to a frame (130), the winding roll comprising a longitudinal axis (122) (p. 6, lines 28-32). The apparatus also includes a motor operably connected to the winding roll (120) for rotating the winding roll about its longitudinal axis (122) (p. 5, lines 10-21 & p. 6, lines 30-31). The apparatus also includes a support roll (140) rotatably attached to the frame (130) (p. 7, lines 4-7), the support roll located a fixed distance from the winding roll, wherein the winding roll and the support roll are arranged on the frame such that tension applied to an adhesive film (112) during removal of the adhesive film from the substrate (114) is transferred to the substrate as compression through the support roll (p. 7, lines 13-19), and wherein the support roll (140) is not located at a release line (116) of the adhesive film (p. 7, lines 20-25).

Claim 23 depends from claim 22 and recites that the support roll (140) comprises an outer conformable surface (p. 8, lines 26-28).

Claim 24 depends from claim 22 and recites that the motor comprises a variable speed motor (p. 5, lines 10-21).

Claim 25 depends from claim 22 and recites that the apparatus includes a heating device (150) (p. 9, lines 3-13).

VI. ISSUES PRESENTED FOR REVIEW

1. Whether, under 35 U.S.C. § 102(b), claims 1, 4, 8-13, 17, 21, 22, and 25 are patentable over French Patent Publication 2643487 to Apollonio et al.
2. Whether, under 35 U.S.C. § 102(b), claims 1, 5, 8-10, 12, 18, 21-22, and 25 are patentable over U.S. Patent No. 5,891,298 to Kuroda et al.
3. Whether, under 35 U.S.C. § 103, claims 23 and 24 are patentable over French Patent Publication 2643487 to Apollonio et al.

VII. GROUPING OF CLAIMS

For the purpose of this appeal, claims 1, 4, 8-13, 17, 21, 22, and 25 stand or fall together; claims 1, 5, 8-10, 12, 18, 21, 22, and 25 stand or fall together; and claims 23 and 24 stand or fall together.

VIII. ARGUMENT

A. The inventions recited in claims 1, 4, 8-13, 17, 21, 22, and 25 are patentable over French Patent Publication 2643487 to Apollonio et al. under 35 U.S.C. § 102(b).

Claims 1, 4, 8-13, 17, 21, 22, and 25 were rejected under 35 U.S.C. § 102(b) as being unpatentable over French Patent Publication 2643487 to Apollonio et al. Applicants respectfully disagree and request review and reversal of this rejection for the following reasons.

A copy of the English translation of Apollonio considered during prosecution is attached in Appendix B (and is cited below as "*Apollonio Translation*").

Apollonio discloses a method and apparatus for removing and applying films to sign surfaces. The methods and apparatus make "it possible to remove and/or hang, simultaneously or independently, poster strips on a plane support" *Apollonio Translation*, p. 1, lines 3-5. The apparatus includes a carriage that rides along a pole (1) on rollers (6) & (7) that are located on opposite sides of the pole. See, e.g., *Apollonio Translation*, p. 3, lines 12-17 and Figures 1 & 3.

In support of the rejection, it is asserted that Apollonio teaches "a film removal method and apparatus comprising applying tension over the width of the adhesive film by adhering the film to a take up roll, 24, [and] transferring the tension onto the substrate through a compressive roller, 34" *Final Office Action*, p. 2, ¶ 2, lines 3-5 (January 2, 2003).

Applicants traverse the asserted interpretation of the teachings of Apollonio et al., noting that the requirements for a proper § 102 rejection based on inherent characteristics of the methods and apparatus taught by Apollonio et al. have not been met. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *MPEP* § 2112, p. 2100-52, 8th Ed., Rev. 1, (Feb. 2003) (emphasis in original) (citing *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)) . "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In response to Applicants' traversal, it was noted in the Final Office Action that "[i]t is the examiner's contention that the basic structures of both Apollonio et al. and Kuroda et al. are equivalent to the structure of the instant invention. For this reason, the properties of physics in Apollonio et al. and Kuroda et al. would parallel the properties of physics in the instant invention which transfers the tension back onto the substrate." *Final Office Action*, p. 4, ¶ 7, lines 3-7 (January 2, 2003).

Applicants traverse these assertions, i.e., that the basic structures are equivalent and that, necessarily, the laws of physics would result in a transfer of tension to the substrate, in their response filed on March 27, 2003. Apollonio et al. contains no discussion regarding the transfer of tension forces to compression onto the substrate. More specifically, the Office Actions have "not presented any basis in fact or technical reasoning to the contrary beyond conclusory statements that the structures are 'equivalent' and that the 'properties of physics' in the present invention 'parallel' those of Apollonio." *Amendment & Response under 37 C.F.R. § 1.116*, p. 8, lines 4-8 (March 27, 2003).

The Advisory Action, however, again failed to address the basic issue, namely, the lack of any reasoned technical analysis that would support an anticipation rejection based on inherency. Rather, the Advisory Action provides further conclusory statements to support the rejection such as, e.g., "the parallel geometric structures of the inventions would all transfer forces in the same direction." *Advisory Action*, Continuation Sheet, line 13 (April 2, 2003).

Applicants respectfully submit that such conclusory statements do not address the basic issue of even whether or not the structures of Apollonio et al. are parallel to the structures of the devices used to practice the methods of the present invention. No discussion whatsoever is provided as to how the structures are parallel. And after clearing that hurdle, Applicants have not been presented with any technical reasoning as to why the structures would necessarily operate in the same manner (it being noted that rejected claims 1, 4, 8-13, 17, and 21 are all method claims).

Applicants did, however, provided their own preliminary analysis as to how the apparatus of Apollonio et al. may operate. *See, e.g., Amendment & Response under 37 C.F.R. § 1.116*, p. 7, lines 8-13 (March 27, 2003). It is noted in the Advisory Action that Applicants' analysis was not supported by affidavit or declaration. Until the Office meets its burden to establish a *prima facie* case of anticipation through inherency, however, Applicants are not required to provide evidence to the contrary. Furthermore, in the absence of any "technical reasoning" provided in support of this rejection, Applicants cannot address the technical reasoning employed by the Examiner in any such affidavits or declarations.

In what could be an attempt to draw attention away from the burdens on the Office to establish a valid inherent anticipation rejection, it was also asserted in the Advisory Action that "[b]y merely stating that the forces in the instant invention are transferred back to the substrate they wish this to be taken as an absolute fact without supporting evidence in an affidavit or declaration." *Advisory Action*, Continuation Sheet, lines 5-7 (April 2, 2003). Applicants traverse this assertion noting that the inventors of the claims at issue here have, in fact, executed a declaration indicating that they each "have reviewed and understand" both the specification and the claims. Each of the inventors also declared "that all statements made herein of his own

knowledge are true and that all statements made on information and belief are believed to be true." *Declaration, Power of Attorney, and Petition*, (signed March 14 & 16, 2001 and submitted April 23, 2001). As a result, the Examiner's position is without merit.

In view of all of the above, Applicants submit that the Office has not met its burden in establishing "inherency" of the claimed subject matter in Apollonio et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

B. The inventions recited in claims 1, 5, 8-10, 12, 18, 21-22, and 25 are patentable over U.S. Patent No. 5,891,298 to Kuroda et al. under 35 U.S.C. § 102(b).

Claims 1, 5, 8-10, 12, 18, 21-22, and 25 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,891,298 to Kuroda et al. Applicants respectfully disagree and request review and reversal of this rejection for the following reasons.

Kuroda et al. teach an apparatus and methods for peeling protective adhesive tape (3) from a substrate. The peeling is performed by applying a peeling tape (5) to the protective adhesive tape (3) and then peeling both the peeling tape (5) and the protective adhesive tape (3) from the underlying substrate. A first roller (8) applies pressure to the back of the peeling tape (5), while a second roller (6) defines a release line along which the peeling tape (5) and the protective adhesive tape (3) are removed. *See, e.g., Kuroda et al.*, Figs. 8 & 13.

In support of the rejection, it is asserted that Kuroda et al. teaches "a film removal method and apparatus comprising applying tension over the width of the adhesive film by adhering the film to a take up roll, 18, [and] transferring the tension onto the substrate through a compressive roller, 8" *Final Office Action*, pp. 2-3, ¶ 3, lines 2-5 (January 2, 2003).

Applicants traverse the asserted interpretation of the teachings of Kuroda et al., noting that the requirements for a proper § 102 rejection based on inherent characteristics of the methods and apparatus taught by Kuroda et al. have not been met. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *MPEP* § 2112, p. 2100-52, 8th Ed., Rev. 1, (Feb.

2003) (emphasis in original) (citing *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In response to Applicants' traversal of this rejection, it was noted that "[i]t is the examiner's contention that the basic structures of both Apollonio et al. and Kuroda et al. are equivalent to the structure of the instant invention. For this reason, the properties of physics in Apollonio et al. and Kuroda et al. would parallel the properties of physics in the instant invention which transfers the tension back onto the substrate." *Final Office Action*, p. 4, ¶ 7, lines 3-7 (January 2, 2003).

Applicants traverse these assertions, i.e., that the basic structures are equivalent and that, necessarily, the laws of physics would result in a transfer of tension to the substrate, in their response filed on March 27, 2003. Kuroda et al. contains no discussion regarding the transfer of tension forces to compression onto the substrate. More specifically, Applicants noted that "the Office Action does not present any basis in fact or technical reasoning supporting its assertions beyond conclusory statements that the structures are 'equivalent' and that the 'properties of physics' in the present invention 'parallel' those of Kuroda." *Amendment & Response under 37 C.F.R. § 1.116*, p. 9, lines 23-27 (March 27, 2003).

In response to Applicants' traversal and request for the technical reasoning or basis in fact supporting the conclusions at issue, an Advisory Action issued that again failed to address the basic issue, namely, the lack of any reasoned technical analysis that would support an anticipation rejection based on inherency. Rather, the Advisory Action provided further conclusory statements to support the rejection such as, e.g., "the parallel geometric structures of the inventions would all transfer forces in the same direction." *Advisory Action*, Continuation Sheet, line 13 (April 2, 2003).

Applicants respectfully submit that such conclusory statements do not address the basic issue of even whether or not the structures of Kuroda et al. are parallel to the structures of the

devices used to practice the methods of the present invention. No discussion whatsoever is provided as to how the structures are parallel. And after clearing that hurdle, Applicants have not been presented with any technical reasoning as to why the structures would necessarily operate in the same manner (it being noted that rejected claims 1, 5, 8-10, 12, 18, and 21 are all method claims).

Applicants did, however, provided their own preliminary analysis as to how the apparatus of Kuroda et al. may operate. *See, e.g., Amendment & Response under 37 C.F.R. § 1.116*, p. 9, lines 17-22 (March 27, 2003). It is noted in the Advisory Action that Applicants' analysis was not supported by affidavit or declaration. Until the Office meets its burden to establish a *prima facie* case of anticipation through inherency, however, Applicants are not required to provide evidence to the contrary. Furthermore, in the absence of any "technical reasoning" provided in support of this rejection, Applicants cannot address the technical reasoning employed by the Examiner in any such affidavits or declarations.

In what could be an attempt to draw attention away from the burdens on the Office to establish a valid inherent anticipation rejection, it was asserted in the Advisory Action that "[b]y merely stating that the forces in the instant invention are transferred back to the substrate they wish this to be taken as an absolute fact without supporting evidence in an affidavit or declaration." *Advisory Action*, Continuation Sheet, lines 5-7 (April 2, 2003). Applicants traverse this assertion noting that the inventors of the claims at issue here have, in fact, executed a declaration indicating that they each "have reviewed and understand" both the specification and the claims. Each of the inventors also declared "that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true." *Declaration, Power of Attorney, and Petition*, (signed March 14 & 16, 2001 and submitted April 23, 2001). As a result, the Examiner's position on this issue is without merit.

In view of all of the above, Applicants submit that the Office has not met its burden in establishing anticipation based on inherency of claims 1, 5, 8-10, 12, 18, 21-22, and 25 by Kuroda et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

C. The inventions recited in claims 23 and 24 are patentable over French Patent Publication 2643487 to Apollonio et al. under 35 U.S.C. § 103.

Claims 23 and 24 were rejected under 35 U.S.C. § 103 as being obvious in view of French Patent Publication 2643487 to Apollonio et al. Applicants respectfully disagree and request review and reversal of this rejection for the following reasons.

A copy of the English translation of Apollonio considered during prosecution is attached in Appendix B (and is cited below as "Apollonio Translation").

Apollonio et al. discloses a method and apparatus for removing and applying films to sign surfaces. The methods and apparatus make "it possible to remove and/or hang, simultaneously or independently, poster strips on a plane support" Translation, p. 1, lines 3-5. The apparatus includes a carriage that rides along a pole (1) on rollers (6) & (7) that are located on opposite sides of the pole. *See, e.g.*, Apollonio Translation, p. 3, lines 12-17 and Figures 1 & 3.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143.

Applicants submit that claims 23 and 24 are not *prima facie* obvious because, at a minimum, Apollonio et al. does not teach all of the elements of claims 23 and 24, both of which depend from independent claim 22. As discussed above with respect to the anticipation rejection of claim 22 based on Apollonio et al., the cited reference does not teach all of the limitations of independent claim 22. Applicants further submit that no suggestion or motivation has been identified in support of this obviousness rejection that would lead one of ordinary skill in the art to modify the apparatus of Apollonio et al. to reach the invention of claim 22 and, thus, claims 23 and 24.

With respect to the rejection of claims 23 and 24, Applicants submit that these claims recite additional features that further define the patentability of the invention recited in claim 22.

For the above reasons, Applicants respectfully request review and reversal by the Board of the rejection of claims 23 and 24 as obvious in view of Apollonio et al.

IX. SUMMARY

It is respectfully submitted that all of pending claims 1, 4-13, and 17-25 are patentable. It is earnestly requested that the Board reverse the Examiner's rejections of claims 1, 4, 5, 8-13, 17, 18, and 21-25, and that all of the claims be allowed.

Respectfully submitted for

Conrad V. ANDERSON et al.

By

Mueting, Raasch & Gebhardt, P.A.

P.O. Box 581415

Minneapolis, MN 55458-1415

Phone: (612) 305-1220

Facsimile: (612) 305-1228

28 AUGUST 2003

Date

By: 

Kevin W. Raasch

Reg. No. 35,651

Direct Dial (612)305-1218

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